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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/756,177

01/13/2004

Charles W. Champ

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7590

11/20/2006

CRUTSINGER & BOOTH

1601 ELM STREET

SUITE 1950

DALLAS, TX 752014744

EXAMINER

PERREIRA, MELISSA JEAN

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,177

Applicant(s)

CHAMP ET AL.

Examiner

Melissa Perreira

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 27-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/16/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election **without** traverse of Group I, claims 1-26 is acknowledged.
2. Claims 27-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse.

Oath/Declaration

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of **50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter a.) - c.) listed below. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

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5. a.) the recitation of the solvent has an electrical conductance in the range of about 1 micro mho or 1-10 micro mho measured at a temperature of 21°C of the instant claims 14 and 15 is not found in the specification.
6. b.) the recitation of the pH of the mixture between 2.2 and 3.3 of the instant claim 20 is not found in the specification.
7. c.) the recitation of the temperature of the mixture is controlled within the range of about 38°C to about 54°C of the instant claim 22 is not found in the specification.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what constitutes an "effective amount" of lipid-soluble compound to balance the water-soluble compound in a lipid- and hydro-guest composition and what type of effect is desired for such a compound.

It is respectfully pointed out that instant claim 25 is a product-by-process limitation. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed Cir. 1985). See MPEP 2113.

Claim Rejections - 35 USC § 102

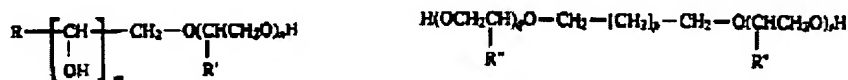
10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Fowler et al. (US 5,534,265).

12. Fowler et al. (US 5,534,265) discloses a personal cleansing composition utilizing insoluble micronized cleansing particles of defined particle size, water-soluble gelling agent, water, surfactants (nonionic, amphoteric), and emollients that provide improved cleansing performance (abstract; column 4, lines 18+; column 5, lines 10-20; column 11, lines 5-13; column 16, lines 53+). The emollients are materials such as alkoxyated ethers and diethers (below) that would be capable of forming crown ether (host) compounds that encompass those of the disclosure.



Additional components of the compositions may include anti-acne, antioxidants, chelating agents, cosmetic astringents, etc., such as tocopherol, retinoic acid and salicylic acid that would generate a skin cleansing composition that has the same

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exfoliating characteristics as the composition of the instant claim (column 18, lines 54+; column 19, lines 12,13 and 21).

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,6,8-15,17,18,25 and 30 of U.S. Patent No. 6,676,951B1 in view of Blank et al. (US 5,776,917). The instant claims drawn to a method of making a skin exfoliating composition and process of making the host composition of US 6,76,951B1 include the same nonionic surfactant, such as dodecatriethoxylate, amphoteric surfactant, such as amino dodecacarboxylic acid, solvents (ethanol or water), aromatic molecule, aluminum cation, such as aluminum

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sulfate, water-soluble compound, such as trans retinoic acid, tocopherol and Bronsted-Lowry acid, such as nonoxyl-9. The composition ratios are exactly the same in regards to the nonionic surfactant relative to the amphoteric surfactant, solvents, aromatic, aluminum cation and Bronsted-Lowry acid. The intermolecular polarity of the compositions is also disclosed to be the same, between 1.8 debye to about 20 debye at 21°C. The process of making the host composition of US 6,676,951B1 does not necessarily include mixing at least one water-soluble compound with the host composition as seen in the instant claims and does not necessarily contain every additive but the instant application and US 6,676,951B1 are not patentably distinct from each other because claim 6 of US 6,676,951B1 does involve the addition of a water-soluble compound thus generating a composition comparable to that of the skin exfoliating composition of the instant claims therefore the compositions are not distinct.

15. Blank et al. (US 5,776,917) discloses a pharmaceutical composition for regulating wrinkles or atrophy in mammalian skin that contains salicylic acid (derivatives) (column 2, lines 19-40 and 62+). The pH and solvents, such as ethanol included in the composition encompasses those of the instant claims (column 3, lines 6-26). Salicylic acid is a key additive in many skin-care products for the treatment of acne, psoriasis, keratosis pilaris, etc and is present in the composition from 0.2 to about 5 % by weight (column 3, lines 11-12). It acts by causing skin cells to slough off more readily, preventing pores from clogging up. Anti-oxidants, such as tocopherol (vitamin E) may be added to such as composition from about 0.1%-10%, more preferably 1%-5% of the composition (column 7, lines 1-6) while trans-retinoic acid included in the

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composition may be from about 0.01% to about 1% of the composition (column 7, lines 40-52). It would be obvious to include salicylic acid and other additives from the composition for regulating wrinkles in the formulation of Champ et al. (US 6,676,951B1) as disclosed by Blank et al. (US 5,776,917), especially salicylic acid (derivatives) for its ability to remove skin cells as is required by an exfoliating composition and its therapeutic function. Retinoids and salicylic acid are routinely used to treat psoriasis and it would be obvious to utilize the composition for such as purpose while the exfoliating properties remove the unwanted dead skin cells.

Conclusion

No claims are allowed at this time.

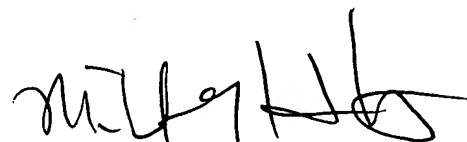
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Perreira whose telephone number is 571-272-1354. The examiner can normally be reached on 9am-5pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MP
October 30, 2006



MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER